

## REMARKS/ARGUMENTS

### REMARKS/ARGUMENTS

The following issues are outstanding in the present application:

- Claims 1-10, 13-34 and 49-81 were rejected under U.S.C. § 103(a) in view of Frid (U.S. Patent No. 6,149,682); and
- Claims 82-145 were objected to as being allowable if written in independent format.

Applicant respectfully traverses all of the rejections and requests reconsideration and withdrawal of the Examiner's outstanding rejection in light of the amendments and remarks contain herein.

#### *The Rejection of Claims 1-10, 13-34 and 49-81 Under 35 U.S.C. § 103(a)*

Claims 1-10, 13-34 and 49-81 were rejected under 35 U.S.C. § 103(a) in view of Frid. Applicants respectfully traverse the rejection. Withdrawal of the rejection is requested.

After reviewing the Examiners rejection, the Applicant is concerned that the examiner has not examined the currently pending claims. Applicant requests that the examiner review the attached claim listing.

A rejection under 35 U.S.C. § 103(a) is only appropriate where each and every feature set forth in the rejected claims is present in the cited reference(s). The Examiner has not established *prima facie* obviousness. Specifically, the Examiner has not provided a reference that: 1) teaches or suggests each and every element of the claimed invention (1-10, 13-34 and 49-81); and 2) provides motivation to modify the teachings of Frid. The Examiner states that "Frid discloses a bifurcated endoprosthesis having a main portion with tapered end, and side opening and a side limb attached to the side opening". Office Action at page 2, emphasis added. However, claims 1 and 49 recite "a main covered stent having a main stent covered by a graft and defining an opening, and having a leading end and a trailing end, wherein the main covered stent tapers in cross-sectional diameter toward the trailing end and the leading end". Frid does not teach or suggest a main stent that tapers in cross-sectional diameter toward the trailing

end and the leading end. Claim 51 recites “a main covered stent having a main stent covered by a graft and defining an opening, and having a leading end and a trailing end, wherein said main covered stent exhibits a constriction near said leading end and a constriction near said trailing end”. These specific structural elements are neither taught nor suggested by Frid. Hence, the Examiner fails to show that Frid teaches or suggests each and every element of the claimed invention. Moreover, the examiner fails to consider a stent that tapers in cross-sectional diameter toward the trailing end and the leading end or a stent that exhibits a constriction near said leading end and a constriction near said trailing end.

Furthermore, even if these elements were present in the cited references, which they are not, there is no motivation to combine these elements to produce the claimed invention. The instant specification is the only source of motivation to modify the teaching of Frid. In fact, modification of the teachings of Frid by adding the recited elements would produce a device unsuitable for the intended purpose of the stent disclosed in Frid. Accordingly, the Applicant respectfully requests withdrawal of the rejection of claims 1-10, 13-34 and 49-81 as purportedly obvious over Frid.

Regarding claims 2-10, 13-34 and 52-81, these claims depend directly or indirectly from claim 1 or 51 and, as such, include all of the limitations thereof. Thus, claims 2-10, 13-34 and 52-81 are not obvious in view of Frid and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

The Examiner has stated that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the diameter of the stent, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” Applicant respectfully disagrees and traverses this rejection. As shown above, Frid does not disclose the elements of the present invention, therefore, it would not be obvious to modify the diameter of Frid.

The Examiner has also stated that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the stent to the graft using the conventional attachment configuration in order to provide an endoprosthesis that can seal off and support the aneurysm as disclosed by Frid.” Applicant respectfully disagrees and traverses this rejection. As shown above, Frid does not disclose the elements of the present invention, therefore, it would not be obvious to attach the stent to a graft.

Applicant believes that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

***Allowable Subject Matter***

Applicant would like to thank the Examiner for indicating that claims 82-145 are allowable.

**CONCLUSION**

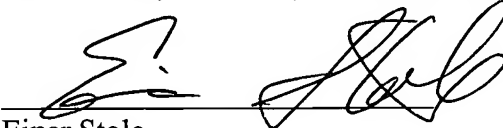
This application is in condition for allowance, and early notice to that effect is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, she is invited to contact applicant's representative by telephone at the number indicated below.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 37428.00109. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MILBANK, TWEED, HADLEY & MCCLOY LLP**

Dated: August 31, 2005

  
Einar Stole  
Registration No. 47,272

**Customer No. 000038647**  
**Milbank, Tweed, Hadley & McCloy LLP**  
International Square Building  
1825 Eye Street, N.W., Suite 1100  
Washington, D.C. 20006  
Telephone: (202) 835-7504